

REMARKS

Reconsideration of the pending application is respectfully requested on the basis of the following particulars.

1. Interview summary

The applicants are appreciative of the opportunity to discuss the pending application with Examiner Battula on October 22, 2009. During the interview, the subject matter of the pending claims and U.S. patent 5,688,587 (*Burchard*) were discussed.

During the interview, applicant's representative discussed a proposed amendment to claims 1 and 24. The proposed amendment adds to the claims language that indicates that information conveyed by the overall contour of the first information is different from information conveyed by the overall contour of the second information. The proposal also removes from the claims the language indicating that the form of the letters, numbers or geometrical figures forming the second information is different from that of the first information.

The Examiner agreed that an amendment to claims 1 and 24 that includes the language added to the claims in the proposed amendment and that further maintains the language deleted from the claims in the proposed amendment would overcome the outstanding rejections.

It was agreed that since *Burchard* discloses only that the print 8 can have the same overall shape as the gaps 5 ("PL" as shown in Fig. 7), *Burchard* does not teach or suggest a security element wherein information conveyed by the overall contour of first information is different from information conveyed by the overall contour of second information, as recited in the proposed amendment.

2. In the claims

Claims 1 and 24 are amended to recite that information conveyed by an overall contour of the first information is different from information conveyed by an

overall contour of the second information. Support for this amendment is found on page 9, lines 1-11 and 16-20, and Figs. 3 and 4, as originally filed.

It is clear that there is support in the specification for the amendatory language; thus, no new matter is added by these amendments.

Entry of the Amendment to the claims is respectfully requested in the next Office action.

3. Rejection of claims 1, 2-5, 9, 11, 14, 15 and 17-22 under 35 U.S.C. § 102(b) as being anticipated by U.S. patent 5,688,587 (*Burchard*)

Rejection of claims 1, 2-5, 9, 11, 14, 15 and 17-22 under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent 5,688,587 (*Burchard*)

Reconsideration of these rejections is respectfully requested in view of the amendments to independent claim 1 and the following remarks which demonstrate that *Burchard* does not teach every feature of the pending claims, and further that the proposed modification of *Burchard* does not render the pending claims *prima facie* obvious.

In observing amended claim 1, the claim is directed to a security element comprising a cover layer having gaps in the form of characters or patterns forming visually and/or machine readable first information, and a printed image in the form of letters, numbers or geometrical figures forming visually and/or machine readable second information printed within the gaps. Claim 1 further requires that the information conveyed by the overall contour of the first information is different from the information conveyed by the overall contour of the second information.

Burchard does not disclose a security element having gaps forming first information and a printed image forming second information printed within the gaps, wherein information conveyed by the overall contour of the first information is different from information conveyed by the overall contour of the second information, as required by amended claim 1.

In a first embodiment, *Burchard* discloses a security document having a transparent plastic layer 6 provided in some areas with a metallic coating having gaps 5 in the form of characters or patterns (col. 4, lines 36-39). In metal-free intermediate areas 7 there is a print 8 which can have any desired color design, such as a multicolor depiction of the flag of a country (col. 4, lines 36-45). The rejection relies on the gaps 5 and the print 8 as respective teachings of the first information and the second information of the pending claims.

In a separate embodiment, *Burchard* discloses that the print 8 and the gaps 5 can have the same form so that they can be disposed one within the other (col. 5, lines 20-24; Fig. 7). The rejection relies on a security element in *Burchard* resulting from a substitution of the multicolor flag print 8 of the first embodiment for the print 8 in the embodiment of Fig. 7.

As was discussed during the interview, since *Burchard* discloses only that the print 8 can have the same overall shape as the gaps 5 ("PL" as shown in Fig. 7), *Burchard* does not teach or suggest a security element wherein information conveyed by the overall contour of first information is different from information conveyed by the overall contour of second information.

Indeed, as *Burchard* discloses that the print 8 has the same overall shape as the gaps 5, the skilled artisan would not understand or be inclined to provide a gap and a print in a security element wherein information conveyed by an overall contour of the gap is different from information conveyed by an overall contour of the print.

As such, *Burchard* does not disclose a security element having gaps forming first information and a printed image forming second information printed within the gaps, wherein the information conveyed by the overall contour of the first information is different from the information conveyed by the overall contour of the second information, as recited in amended claim 1.

In view of these observations, it is respectfully submitted that *Burchard* fails to anticipate the pending claims of this rejection, and further that the proposed

modification of *Burchard* fails to render the pending claims of this rejection *prima facie* obvious. Accordingly, withdrawal of these rejections is kindly requested.

Claims 2-5, 9, 11, 14, 15 and 17-22 are also considered to be patentable as containing all of the elements of claim 1, as well as for their respective individually recited features.

4. Rejection of claims 1, 16 and 23 under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent application publication 2005/0151368 (*Heim*) in view of U.S. patent 5,688,587 (*Burchard*)

Reconsideration of this rejection is respectfully requested in view of the amendments to independent claim 1, from which the remaining claims in the rejection depend, and the following remarks which demonstrate that the proposed combination of *Heim* and *Burchard* fails to render the pending claims *prima facie* obvious.

The proposed combination of *Heim* and *Burchard* does not disclose a security element having gaps forming first information and a printed image forming second information printed within the gaps, wherein the information conveyed by the overall contour of the first information is different from the information conveyed by the overall contour of the second information, as required by amended claim 1.

Heim discloses a security document 1 having security elements 2,4 embedded in or applied to the security document so that they are visually recognizable from both sides of the security document (paragraphs [0047] and [0051]).

The rejection relies on gaps 9 in a cover layer D of the security document as a teaching of the first information of the pending claims. The rejection acknowledges that *Heim* does not disclose second information that is different from the first information and turns to the *Burchard* patent to cure these deficiencies.

However, as discussed above, since *Burchard* discloses that the print 8 has the same overall shape as the gaps 5, the skilled artisan would not understand or be inclined to provide a gap and a print in a security element wherein information

conveyed by an overall contour of the gap is different from information conveyed by an overall contour of the print.

As such, the proposed combination of *Heim* and *Burchard* does not disclose a security element having gaps forming first information and a printed image forming second information printed within the gaps, wherein the information conveyed by the overall contour of the first information is different from the information conveyed by the overall contour of the second information, as recited in amended claim 1.

In view of these observations, it is respectfully submitted that the proposed combination of *Heim* and *Burchard* fails to render the pending claims of this rejection *prima facie* obvious. Accordingly, withdrawal of this rejection is kindly requested.

Claims 16 and 23 are also considered to be patentable as containing all of the elements of claim 1, as well as for their respective individually recited features.

5. Rejection of claim 3 under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent 5,688,587 (*Burchard*) in view of U.S. patent 5,573,639 (*Schmitz*)
- Rejection of claims 6, 7 and 27 under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent 5,688,587 (*Burchard*) in view of U.S. patent application publication 2005/0151368 (*Heim*)
- Rejection of claims 10 and 11 under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent 5,688,587 (*Burchard*) in view of U.S. patent 6,344,261 (*Kaule*)
- Rejection of claims 24 and 26 under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent 5,688,587 (*Burchard*) in view of U.S. patent 6,352,804 (*Sakamoto*)
- Rejection of claim 25 under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent 5,688,587 (*Burchard*) in view of U.S. patent 6,352,804 (*Sakamoto*), and further in view of U.S. patent application publication 2005/0151368 (*Heim*)

Reconsideration of these rejections is requested in view of the amendment to claim 1 and the discussion provided above. The claims of the above-identified rejections are dependent from claim 1. It is respectfully submitted that none of *Schmitz*, *Heim*, *Kaule* and *Sakamoto*, make up for the aforementioned shortcomings of *Burchard* as discussed above with respect to amended claim 1, from which all remaining pending claims depend.

In particular, none of the above cited patents and publications discloses a security element having gaps forming first information and a printed image forming second information printed within the gaps, wherein the information conveyed by the overall contour of the first information is different from the information conveyed by the overall contour of the second information, as is required by amended claim 1.

Accordingly, it submitted that the proposed combinations of *Schmitz, Heim, Kaule* and *Sakamoto* with *Burchard*, and *Burchard* alone fail to establish a *prima facie* case of obviousness with respect to amended claim 1, from which all remaining pending claims depend. Therefore, withdrawal of these rejections is respectfully requested.

6. Conclusion

As a result of the amendment to the claims, and further in view of the foregoing remarks, it is respectfully submitted that the application is in condition for allowance. Accordingly, it is respectfully requested that every pending claim in the present application be allowed and the application be passed to issue.

If any issues remain that may be resolved by a telephone or facsimile communication with the applicants' attorney, the examiner is invited to contact the undersigned at the numbers shown below.

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Respectfully submitted,



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